

Hearing:
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Paper No. 32

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Color-Clings, Inc.
v.
Creative Horizons, LLC

Opposition No. 104,054
to application Serial No. 75/030,309
filed on December 4, 1995

Paul P. Kempf of Kinney & Lange, P.A. for Color-Clings, Inc.

Roger L. Browdy of Browdy and Neimark, P.L.L.C. for Creative Horizons, LLC.

Before Wendel, Bucher and Rogers, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Creative Horizons, LLC., a Maryland Corporation, has filed an application for registration of the mark "CLING THINGS" for "stickers and reuseable peel-off plastic sheets containing graphic designs" in International Class 16.¹

¹ Serial No. 75/030,309 filed on December 4, 1995, alleging dates of first use of September 22, 1994.

Color-Clings, Inc., a Minnesota corporation, filed a timely notice of opposition on November 21, 1996. As grounds for opposition, opposer asserts that applicant's mark so resembles the previously used and registered trademark "COLOR-CLINGS" for "non-adhesive window decorations made of a polymer material" in International Class 20² as to be likely, when applied to applicant's goods, to cause confusion, or to cause mistake, or to deceive.

Applicant, in its answer, has admitted that it filed the instant application, but has otherwise denied the salient allegations in the notice of opposition.

The record consists of the pleadings; the file of the opposed application; the deposition (with related exhibits) taken by opposer of David Goldberg, formerly vice-president and then president of opposer (1993 to 1998); opposer's notice of reliance on applicant's answers to interrogatories, applicant's notice of reliance on opposer's answers to applicant's second set of interrogatories; and, a copy of the registration as an exhibit to Mr. Goldberg's testimony, establishing that the registration is still subsisting and is owned by the offering party.

² Opposer is the owner of Registration No. 1,778,369, issued on June 22, 1993 from an application filed on April 24, 1991, which sets forth dates of first use of November 30, 1992; §8 affidavit accepted and §15 affidavit received.

Both parties filed briefs on the case and both were represented by counsel at an oral hearing held before the Board.

Because opposer properly made of record the above registration, priority is not an issue. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). As the parties agree, the sole issue in this proceeding is whether the contemporaneous use of applicant's mark and opposer's marks on these substantially identical goods is likely to result in confusion, mistake or deception.

In the course of rendering this decision, we have followed the guidance of In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). This case sets forth the factors that should be considered, if relevant, in determining likelihood of confusion.

Because the goods of the parties are substantially identical,³ a number of du Pont factors favor opposer. With identical goods, it must be assumed there will be identical channels of trade and identical types of purchasers. Moreover, given the inexpensive nature of these impulse purchases, we find that these common purchasers would

³ Despite differences in the terminology of the respective identifications of goods and their differences in international classification, the uncontradicted testimony of Mr. Goldberg and the attached exhibits demonstrates that applicant's goods are essentially identical to registrant's goods.

exercise nothing more than an ordinary degree of care in making their purchases.

However, there is one du Pont factor which clearly favors applicant and which causes us to find that there is no likelihood of confusion. Put quite simply, we believe that opposer's mark "COLOR-CLINGS" is so dissimilar from applicant's mark "CLING THINGS" that there is no likelihood of confusion. Our primary reviewing Court has made it clear that in appropriate cases, one du Pont factor can outweigh all of the other factors. See Kellogg Co. v. Pack'em Enterprises, 951 F.2d 330, 21 USPQ2d 1142, 1144 (Fed. Cir. 1991). This is "especially [true] when that single factor is the dissimilarity of the marks." Champagne Louis Roederer v. Delicato Vineyards, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998). In Champagne Louis, the Court affirmed a decision of this Board in which it was found that the contemporaneous use by applicant of "CRYSTAL CREEK" for wine and by opposer of "CRISTAL" and "CRISTAL CHAMPAGNE" for wine would not result in a likelihood of confusion.

In the present case, the word "cling" is a significant portion of each mark. Further, both "COLOR-CLINGS" and "CLING THINGS" do have the same number of letters, and each ends with the plural form of somewhat different words, and each contains a terminal suffix that rhymes with the other party's mark.

However, in order to make the correct determination under likelihood of confusion, we must still determine the strength of opposer's mark. In this regard, it is clear from the record that these goods are known in the trade as "clings," "window clings," "static clings," or "static cling window decorations." For example, from the header placed across the top of one of these 17" x 11" sheets of "static cling window decorations" marketed by "COLOR-CLINGS,"⁴ we see that each of these Valentine decorations "*clings* to most non-porous surfaces." The two-step instructions are as follows:

1. Clean window to be decorated, leave damp.
2. Remove *cling* and apply non-printed side (side connected to backing) to window...

In the brief text of this header, the word *clings* is used as a verb and the word *cling* as a noun. Both confirm the generic usage of this word in conjunction with these goods. Hence, the only common root in both marks ("clings" and "cling" respectively) is obviously a generic designation. Furthermore, opposer admits that as to these decorative items, opposer's mark "COLOR-CLINGS" was selected "for its suggestive nature."⁵ On cross-examination by applicant's counsel, Mr. Goldberg also testified to his

⁴ Goldberg testimony, exhibit 3.

⁵ See opposer's answer to applicant's second set of interrogatories, no. 15.

knowledge of various third parties that used in a prominent fashion in their trademarks various forms of the word "cling," "kling," or "clings."⁶

Accordingly, we find that this highly suggestive mark is not entitled to a broad scope of protection in spite of the apparent success opposer (and its predecessors in interest) have had in this niche market since 1992.⁷

Decision: The opposition is dismissed.

H. R. Wendel

D. E. Bucher

G. F. Rogers

Administrative Trademark
Judges, Trademark Trial and
Appeal Board

⁶ Goldberg testimony: Impact Plastics Advertising, Inc.'s "CLASSIC CLINGS," pp. 45-48; Superior Silk Screen Industries, Inc.'s "KLINGERS," pp. 55-56; Lee Display Materials, Inc.'s "KLING-ONS," p. 58; Kenneth L. Moore's "CLING-ONS," pp. 59-60; Impact Plastics Advertising, Inc.'s "CLINGS FOR KIDS (and design)," p. 61; and, Daisy Kingdom, Inc.'s "WINDOW-WONDERS STATIC CLING DECORATIONS," PP. 63-64.

⁷ Although opposer has alleged that its mark, "COLOR-CLINGS," is famous, we do not believe that the evidence of opposer's overall levels of gross sales alone supports a determination of fame.